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10/825,178

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EXAMINER

DEGHAN, QUEENIE S

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 10/825,178  
Filing Date: April 16, 2004  
Appellant(s): NISHIMOTO ET AL.

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Michael E. Fogarty  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed November 21, 2008 appealing from the Office action mailed March 27, 2008.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

Derwent Abstract to NL 8600728, "Compact disc with optically recorded signal tracks consists of two identical discs joined together to make double-sided recording", assigned to Philips Gloeilampenfab (Oct. 16, 1987)

Art Unit: 1791

Suzuki, H. "Disk Driving Device" JP 2000182316 (June 30, 2000)

US 2003/0109370

Ikenishi et al.

6-2003

### **(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

#### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

1. Claims 20 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Philips (Derwent Abstract to NL8600728), Ikenishi et al. (2003/0109370) and Suzuki (JP 2000182316). Philips discloses a process for manufacturing a glass substrate to be utilized as a recording medium comprising creating a center hole so that the center of gravity becomes the center of the center hole (abstract). It would have

Art Unit: 1791

been obvious to one of ordinary skill in the art at the time of the invention to expect that the center of gravity is detected in the process of Philips in order to assess that the center of gravity is in the center of the center hole. Although not specifically disclosed by Philips, other method for manufacturing glass substrates for use as a recording medium is also known in the art such as that disclosed by Ikenishi et al. Ikenishi et al. disclose a process for manufacturing a glass substrate comprising melting a glass material, flowing the melted glass into a lower mold, press molding the glass between an upper mold and the lower mold into a glass substrate, and creating a center hole in the glass substrate ([0069], [0071], [0080], [0125]). Additionally, Suzuki teaches the need for recording medium such as CD's to have no eccentricity in order to prevent vibration (abstract, ([0002], [0004], [0007])). That is, the center of gravity should be placed in the center of the central hole of recording medium to minimize vibrations which causes reading errors. It would have been obvious to one of ordinary skill in the art at the time of the invention to alternatively employ the different known ways to produce a glass substrate, such as injection molding or press-molding, as taught by Philips and Ikenishi et al. because both produces predictable and similar results. Additionally, it would have been obvious to one of ordinary skill in the art at the time of the invention to utilize the method step of Philips of creating a center hole so that the center of gravity becomes the center of the central hole while creating the central hole of the glass substrate in the process of Ikenishi et al. because Suzuki teaches the strong desired for no eccentricity in order to minimize vibrations that causes reading errors of the recording medium.

Art Unit: 1791

3. Furthermore, Suzuki provides a method for measuring the center of gravity on a glass substrate by carrying out image processing on a two dimensional image as viewed from the direction of the thickness of the glass substrate by use of a CCD sensor (drawing 1, abstract). It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the step of detecting the center of gravity and the detecting means of Suzuki in the process Philips and Ikenishi in order to provide for a well balanced recording medium and prevent reading errors.

#### **(10) Response to Argument**

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., detecting the center of gravity before creating a center hole) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Reading the claim broadly, it does not specifically recite a sequence to the method steps. The claim is interpreted as comprising a detecting step and a creating a hole step, which Phillips discloses creating a hole so that the center of gravity is at the center of the center hole. As mentioned above, the detecting step would have naturally been performed, since it is necessary for determining that the center of gravity is in center of the hole.

Furthermore, the applicant suggests that Phillips discloses a quality control step of inspecting a final product. Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable

Art Unit: 1791

invention without specifically pointing out how the language of the claims patentably distinguishes them from the references. In fact, Phillips list an advantage to the disclosed method of forming the substrate is that the mass is evenly distributed with the center of gravity at the center of the hole, which contradicts the applicant's argument. There is no advantage to a method that would suggest discarding a final product.

The applicant also argues that Suzuki teaches away from claim 20 because eccentricity is measure after the hole is created and corrects for it with a sticker. Although the Suzuki reference teaches other method steps, it offers an important teaching and emphasis that the center of gravity should always exist at the center (of the hole) in order to have a balanced media and prevent reading errors. This teaching makes it obvious to one ordinary skill in the art to detect a center of gravity and to place the center of gravity at the center of a center hole.

**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Queenie S. Dehghan/

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Art Unit: 1791

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